REMARKS

This is in response to the Final Rejection of June 2, 2004, in this application. An RCE is being filed herewith to continue the prosecution of this application. The Final Rejection acted on claims 87-166. By this amendment, applicant is amending claims 87, 97, 107, 117, 127, 137, 147, 157 and adding new claims 167 through 194. Claims 87-194 include independent system claims 87, 97, 127, 137, 167 and 174, independent method claims 107, 117, 147, 157, 181 and 188. Furthermore, pairs of the claims are generally similar with the exception that one claim of the pair refers to a constraint whereas the other claim of the pair does not. For example, claim 87 includes "selecting means which selects bids to maximize a function of the value parameters P_i of the selected bids." Claim 97 refers to "selecting means which selects bids to maximize a function of the value parameters P_i of the selected bids subject to the constraint that the sets S_i identified by the selected bids are compatible." A similar relation exists between the pair of system claims 127 and 137 as well as the pair of system claims 167 and 174. A similar relationship can be found among pairs of method claims. For example, method claim 107 calls for "the selecting of bids to maximize a function of the value parameters P_i of the selected bids." Claim 117 recites "the selecting of bids to maximize a function of the value parameters P_i of the selected bids subject to the constraint that the sets S_i identified by the selected bids are compatible." A similar relation exists between the pair of method claims 147 and 157, and the pair of claims 181 and 188.

Claims 87 through 166 indicate that bids include a set identification P_i and a value parameter P_i. The new claims 167 through 174 differ by specifying transmitting to users information "including at least a current proposed price for each of the plurality of types of items." The bids are specified to include a set identification S_i. Support for sending price information to users is found in col. 6, lines 37-49 of U.S. Patent 5,905,975, which issued on application S/N 775,880 which was the ultimate parent to this application and of which this application is a continuation.

New claims 167 -194 refer to "a computer" in several different contexts. The claims do not indicate whether the second recitation of a computer is the same or different from an earlier

recitation. In other applications claims with similar features have erroneously been rejected as indefinite on the basis that the reader could not determine whether the second recited computer was the same as or different from the first. The MPEP makes it clear that the breadth of a claim is not a basis for finding the claim indefinite. The MPEP provides:

> 2173.04 Breadth Is Not Indefiniteness
> Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Applicant submits that the scope of claims 167-194 is clear. These claims cover combinations wherein the second recitation of a computer refer to the same computer as the first, as well as combinations wherein the second recitation of computer refers to a different computer from the first recitation of a computer. Since the scope of the claim is clear, the claim is definite as set forth in MPEP §2173.04.

In the final Rejection of June 2, 2004, claims 87-90, 92-100, 102-110, 112-120, 122-130, 132-140, 142-150, 152-160 and 162 to 166 were rejected. The other claims (91, 101, 111, 121, 131, 141, 151, and 161) were objected to; the action indicated as containing allowable subject matter. The indication of allowable subject matter is acknowledged with appreciation.

There is only rejection in the Final Rejection and that rejection is based on a combination of ONSALE and Fujisaki. The Final Rejection indicates that Fujisaki is relied on for a "decision means." In particular, Fujisaki at 7:24-27, 53-61; 10:32-59; 13:21-27 is relied on with respect to the allegation that Fujisaki teaches a decision means. The rejection is bottomed on the allegation that "it would have been obvious" to incorporate the decision means feature of Fujisaki into the ONSALE system to provide certain information to bidders, thereby providing a user friendly system.

The Final Rejection alleges that maximizing a function of the value parameters of selected bids would have been obvious "so as to relate to the highest bidding price to the related item being auctioned." In response to the argument that Fujisaki does not teach auctioning multiple instances of each or plural dissimilar items, the Final Rejection alleges that the ONSALE reference somehow includes "teachings of multiple instances of each or plural dissimilar items." The Action continues that "it should be noted that there are plurality of different items where different bids are continuously placed thereon, as in the combination of ONSALE and Fujisaki, the selection of the highest bids would be disjoint."

The Final Rejection acknowledges that neither reference teaches auctions for television licenses or associated derivative rights. The Final Rejection acknowledges that limiting the number of bids that may be entered by a particular user based on previous bidding activity by that particular user is also not found in either reference.

Rejected claims specify that the auctions which are implemented or conducted are characterized in that the items being auctioned include dissimilar items or types of items. The Office Action alleges that ONSALE describes auctioning different types of items. While the reference may well describe auctioning different types of items, the reference differs from many of the claims because the claims refer to "a computer-implemented auction" of dissimilar items, e.g., one auction in which dissimilar items are subject to the auction. This subject matter, found in claims 127 through 166 is substantially different from either of the references of record on the basis that neither references teaches an (a single) auction during which dissimilar items are auctioned.

One of the major distinctions between all the claims and the combination of references relied on is that neither reference teaches the "decision means responsive to the bid information received from the user systems for determining whether an auction should continue or terminate" as called for in claims 87-106. Likewise, neither of the references teach determining at a computer in response to the bid information whether the auction should continue or terminate as called for in claims 107 through 126.

Claims 127 through 146 call for "means at a computer for determining, based on the signals [which are based on the bid information], the items to be assigned to the users, said determining means including selecting means which selects bids to maximum a function of the value parameters P_i of the selected bids." Claims 147 through 166 call for a step of "determining at a computer, based on the signals [which include bid information] the items to be assigned to the users, said determining including the selecting of bids to maximize a function of the value parameters P_i of the selected bids." New claims 167 through 180 are similar to claims 87 *et seq.* in calling for "means for determining at a computer, in response to the bid information, whether the auction should continue or terminate." Finally, method claims 181 through 194 call for determining at a computer, in response to the bid information, whether the auction should continue or terminate.

The Final Rejection acknowledges that this subject matter is not found in ONSALE but relies on Fujisaki. Applicant submits that Fujisaki does not describe a system for conducting an auction, Fujisaki is limited to describing a system in which information derived from a manual auction (that is an auction conducted by a human auctioneer, not by a machine) is distributed to bidders who are not physically present at the location of the auctioneer. As a consequence, the only apparatus described by Fujisaki is a system for communicating information (derived from the human auctioneer) to the bidders and communicating information from the bidders back to the human auctioneer. It should be readily apparent that in this collection of apparatus, there is no means to determine whether an auction should continue or terminate, or a step of determining (by a computer) whether the auction should continue or terminate because in the Fujisaki system it a human being who decides whether the auction should continue or terminate. The Office Action argues that Fujisaki discloses applicant's decision means at 7:24-27, 53-61. To the contrary, the Fujisaki specification in the cited portions of col. 7, merely refers to a bid up signal where the price is bid up in predetermined increments. This is merely an implementation of the information flow which applicant concedes is found in Fujisaki. It has nothing to do with a decision means to determine whether the auction should continue or terminate or a step of determining whether the auction should continue or terminate. The cited portions of the specification in col. 10 also refers to "the exchange of data." The only exception is the reference in col. 10 to "the program proceeds to sell-off processing when a seller issues a sell-off signal or

when a sell-off price registered in advance by a seller has reached." This merely confirms applicant's argument that the auction is a manual auction e.g., controlled by a human being who specifies the sell-off signal or the sell-off price. The same is true in the cited portion of the specification in col. 13 which deals with data exchange not a decision as to when to terminate an auction.

Applicant submits that all of the claims are patentable for at least this reason.

The new claims include similar subject matter. Claims 167 and 174 call for "means for determining at a computer, in response to the bid information, whether the auction should continue or terminate." Method claims 181 and 188 are similar in calling for "determining at a computer, in response to the bid information, whether the auction should continue or terminate."

All of the claims, (87-194), include another substantial distinction from the references relied on. These claims specify that "at least one of the bids including a set identification S_i identifying at least two different items."

Insofar as applicant can tell, both of the cited references auction goods in lots. An auction, as described in the references, then allows plural bidders to bid against each other for the single lot, subject to the auction. The bidder's bid, then, is only a single number, e.g., what value is the bidder offering for the lot. Applicant has argued throughout the prosecution of this application that the auctions claimed herein are different in that dissimilar items are being auctioned. In order to allow dissimilar items to be auctioned the bidders must be capable of identifying the items which they seek. This is effected by including in their bid information identifying the items sought by each bidder. Neither of the cited references discloses that any bid includes the identification of different items. Nor does either reference provide any bidder with the ability to identify, in a bid, at least two different items. This is not a feature of the reference relied on and applicant submits that all the claims are patentable for this additional reason.

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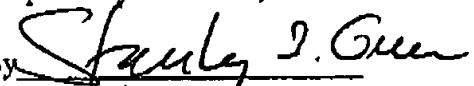
In view of the above, early and favorable action is solicited.

Dated: December 2, 2004

Respectfully submitted,

By 

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